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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,050	08/09/2001	Ryosuke Takeuchi	450100-03410	4114
20999 7590 07/31/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER TRAN, HENRY N	
			ART UNIT 2629	PAPER NUMBER
			MAIL DATE 07/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/927,050

Applicant(s)

TAKEUCHI, RYOSUKE

Examiner

Henry N. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-15 and 17-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-15 and 17-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment received May 24, 2007 has been entered. Claims 1-1-3, 5-15, and 17-34 remain pending in this application. Applicant's Remarks/Arguments have been fully considered; and this Office action is in response thereto.

Response to Arguments

1. Applicant's arguments, see page 13 of the above-identified amendment, with respect to the objections to the drawings, have been noted. The objections to the drawings as recited in item 3 of the prior Office action mailed 10/17/06 have been withdrawn.
2. Applicant's cancellation of claim 4, and amendments to claims 5-10 have overcome the rejections of claims 4-10 and 15 under 35 USC § 112 (2).
3. Applicant's arguments, see pages 13-15 of the above-identified amendment, with respect to the rejections of claims 1-6 and 9-21 under 35 USC § 103 (a) as being unpatentable over U.S. Patent No. 6,332,024 to Inoue et al. (hereinafter referred to as "Inoue") in view of U.S. Patent No. 6,128,012 to Seidensticker Jr. et al. (hereinafter referred to as "Seidensticker Jr.") have been fully considered but they are not persuasive because Inoue in combination with Seidensticker Jr. does teach the claimed invention. Particularly, applicant stated that: (i) "there is no teaching or suggestion in Inoue or Seidensticker for a display unit configured to display a plurality of lists in hierarchy and to eliminate a mark indicating a direction if the point~~er~~ cannot be shifted to another list in the direction from the currently displayed list" [emphasis added]; (ii) "the cited references disclose a controller eliminating a mark if the controller detects there is another item which is not displayed on a currently display list (Figs. 6A, 6B)."; and (iii) and "none of the

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references discloses a controller eliminating the mark based on the existence of other lists". The examiner respectfully disagrees because Inoue and Seidensticker Jr. does teach: (i) "a display unit configured to display a plurality of lists in hierarchy", wherein, each list is a display of the highest levels of dictionary structure, thereby enabling the user to select a specific directory and subdirectory in the hierarchy for accessing desired data; for example, Inoue Fig. 5C illustrates a LCD display unit 2 configured to display a list in a directory mode B2; the list comprises a plurality of lists of registered names and types of telephones, and a lower hierarchy comprising information of one of the list illustrated in Fig. 5D is displayed using the pointer (CB2) and the user operation unit (3, 4A and 4B), see also, col. 8, line 47 to col. col. 9, line 38; and (ii) a controller configured ..., to eliminate a mark indicating a direction if said pointer can not be shifted to another list in the direction from the currently displayed list; for example, Seidensticker, Jr., Figs. 1, 2, 6A and 6B, teaches a controller (CPU 50) configured to implement a function to select an information item listed in a list comprising a plurality of menu items listed in a hierarchy on the display unit 34, and to eliminate a mark (134), which indicates the upper direction (an upwardly pointing arrowhead), from the display unit if the pointer, e.g., bold font indication 130, can not be shifted to another item in the desired upper direction from the currently displayed item, which is "BLACKJACK", because it is the first item listed at the top, see col. 11, line 29 to col. 12, line 19. Clearly, Inoue in view of Seidensticker Jr. does teach the invention as claimed. The detailed rejections of the claims are as follows.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 6 and 11-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of the claims 6 and 11-34 recites at least one limitation that is found insufficient antecedent basis for the limitation in the claim. For example:

Claim 6: on line 6, "the selected piece of information". ("piece" should be changed to --portion--).

Claim 11: on lines 6-7, "the display". ("the display" should be changed to --a display--).

Claim 12: on line 9, "said operation unit". ("unit" should be changed to --portion--).

Claim 14: on line 6, "the display". ("the display" should be changed to --a display--); and on line 9, "said operation unit". ("said operation unit" should be changed to --a operation unit--).

Claim 17: on line 6, "the selected portion of information". ("the selected portion of information" should be changed to --the specified portion of the information-- or to --a selected portion of the information--).

Claim 18: on line 7, "the selected piece of information". ("the selected piece of information" should be changed to --a selected piece of information--).

Claim 20: on line 4, "said operation portion". ("said operation portion" should be changed to --said operation unit--).

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Claim 21: on line 3, “said controller”. (“said controller” should be changed to --a controller--); and on line 4, “said operation portion”. (“said operation portion” should be changed to --said operation unit--);

Claim 25: on line 3, “the display unit”. (“the display unit” should be changed to --the display--).

Claim 27: on line 2, “the display unit”. (“the display unit” should be changed to --the display--).

Claim 28: on line 1, “said controller”. (“said controller” should be changed to --a controller--); and

on line 4, “the display unit”. (“the display unit” should be changed to --the display--).

Claim 29: on line 1, “said controller”. (“said controller” should be changed to --a controller--); and

on lines 3 and 4, “the display unit”. (“the display unit” should be changed to --the display--).

Claim 30: on line 3, “the display unit”. (“the display unit” should be changed to --the display--).

Claim 31: on line 4, “the selected piece of information”. (“the selected piece of information” should be changed to --the selected portion of information--).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5, 6, 9-15, 17-25 and 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al (U.S. Patent No. 6,332,024, "Inoue") in view of Seidensticker, Jr. et al (U.S. Patent No. 6,128,012, "Seidensticker, Jr.").

Regarding claims 1 and 12, Inoue, Fig. 1, teaches a portable communication apparatus (1) comprising: a display unit (2) configured to display a plurality of lists in hierarchy (Inoue Fig. 5C illustrates a LCD display unit 2 configured to display a list in a directory mode B2; the list comprises a plurality of lists of registered names and types of telephones, and a lower hierarchy comprising information of one of the list illustrated in Fig. 5D; wherein, each list is a display of the highest levels of dictionary structure, thereby enabling the user to select a specific directory and subdirectory in the hierarchy for accessing desired data); a pointer (CB2) specifying one portion of information of one of the list, see Fig. 5C; a user operation unit (3, 4A and 4B) and its associated markers, i.e., icons (Up/Down Arrows, Left Arrow, and Right Arrow: IB10, IB11, and IB12); and a controller (CPU 10) configured to shift said pointer to a desired position in accordance with an operation of said operation unit, see also, Fig. 5B, and col. 8, line 47 to col. col. 9, line 38.

However, Inoue does not teach or disclose that the controller is configured to: (i) "eliminate said mark indicating said direction if said pointer can not be shifted to another list in a desired direction from a currently displayed list", or (ii) "eliminate said mark from the display unit if another list does not exist at the next position of said portion of information of a currently displayed list specified by said pointer in the direction which said mark indicates"

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Seidensticker, Jr. teaches a portable communication apparatus (30) comprising a display unit (34), an operation unit (36), and a controller (CPU 50), which is configured to implement a function to select an information item listed in a hierarchy on the display unit, and to eliminate a mark indicating a direction if said pointer can not be shifted to another list in the direction from the currently displayed list (for example, Seidensticker, Jr., Figs. 1, 2, 6A and 6B, teaches a controller (CPU 50) configured to implement a function to select an information item listed in a list comprising a plurality of menu items listed in a hierarchy on the display unit 34, and to eliminate a mark (134), which indicates the upper direction (an upwardly pointing arrowhead), from the display unit if the pointer, e.g., bold font indication 130, can not be shifted to another list (another item) in the desired upper direction from the currently displayed item, which is "BLACKJACK", because it is the first item listed at the top, and other item does not exist at the next upper position), see col. 11, line 29 to col. 12, line 19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the function of eliminating a mark as taught by Seidensticker, Jr. in the Inoue system because this would provide an improved user interface capable of enhancing the functionality and reliability of the control, selection, and viewing data items displayed on a screen, see Seidensticker, Jr., col. 1, lines 12-18.

By said rationale, claims 1 and 12 are rejected.

Regarding claims 2, 3, 5, 6, 9 and 10, Inoue further teaches that the operation unit (3, 4A, and 4B) is a dial and/or a push key, see col. 5, lines 10-15. Seidensticker, Jr. does teaches that the mark 132 indicating a lower direction or the mark 134 indicating an upper direction is eliminated from the display when the list or item in the lower direction of the last item, or when

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the list or item in the upper direction of the first item is not displayed or existed, see Figs. 6A, 6B, and 7; and col. 11, line 55 to col. 12, line 48. Claims 2, 3, 5, 6, 9 and 10 are dependent upon the base claim 1, and are therefore rejected on the same reasons set forth in claim 1, and by the reasons noted above.

Regarding claims 13 and 30-34, which depend upon the base claim 12, and comprises similar claimed elements and limitations of claims 1, 2, 3, 5, 6, 9 and 10, and are therefore rejected on the same basis set forth in claims 1, 2, 3, 5, 6, 9, 10, and 12 discussed above.

Regarding claims 11, 14, 15, 17-25, 28, and 29, which are method claims corresponding to the apparatus claims 1-3, 5, 6, 9, 10, 12, 13, and 30-34, and are therefore rejected on the same basis set forth in claims 1-3, 5, 6, 9, 10, 12, 13, and 30-34 discussed above.

8. Claims 7, 8, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Seidensticker, Jr. (hereinafter referred to as "Inoue-Seidensticker, Jr.") as applied to claims 1 and/or 11 above, and further in view of Yankowski (U.S. Patent No. 6,388,958).

Inoue-Seidensticker, Jr. teaches generally all as discussed above. Inoue further teaches that the controller CPU 10 is configured to reproduce audio data, see figure 2, and col. 6, lines 4-12.

However, Inoue-Seidensticker, Jr. does not teach said portion of information is a title of a song, and a editing unit configured to edit the order of said portions of information on said display unit.

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Yankowski teaches a computer system comprising a display/control unit (82), a memory (72), and a controller (68), which are configured to display information, which is a play list of titles of songs, whose orders can be manipulated, deleted, or rearranged, see col. 10, line 55 to col. 11, line 3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the editing function as taught by Yankowski in the Inoue-Seidensticker, Jr. system because this would be an improved user interface capable of enhancing the selection and playing of the song play list displayed on a screen.

By this rationale, claims 7, 8, 26, and 27 are rejected.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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10. Important Notice To Applicant: In the Response and/or Amendment to reply to this

Office action:

- *Drawings*: Applicant(s) is required to review the drawings for needed corrective actions because the drawings must show every feature of the invention specified in the claims, see 37 CFR 1.83(a). No new matter should be entered.

- *Specification*: Applicant(s) is required, in his/her normal review and/or rewriting of the claims, to review the specification for needed corrective actions because: (i) editorial, typographical, or clerical errors may exist; (ii) The meaning of every term used in a claim may not be apparent from the specification, or inconsistent described in the specification, which may be rejected under 35 USC 112, first and/or second paragraph(s); and (iii) other informalities, which should be corrected to the extent that the disclosure is readily understood and the claims to be examined are in proper form, particularly as to dependency, and otherwise clearly define the invention. "New matter" must be excluded from the amendments, see M.P.E.P § 608.

- In case that the applicant traverses any objection and /or rejection recited in this Office action, applicant is required to provide a concise explanation of the subject matter involved, referring to the specification by page and line number and to the drawings, if any, by reference characters; particularly, (i) identify, for each independent claim and each dependent claim, every claimed features or limitations, or every claimed means plus function and/or step plus function under 35 USC 112, sixth paragraph, and/or (ii) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the

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examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry N. Tran whose telephone number is 571-272-7760. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin H. Shalwala can be reached on 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Henry Tran/
Henry N Tran
Primary Examiner
Art Unit 2629

HT
7/27/07